



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,229	11/14/2001	Yoshinari Ohnishi	35.C15948	6760
5514	7590	01/25/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHEN, WENPENG	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/987,229

Applicant(s)

OHNISHI, YOSHINARI

Examiner

Wenpeng Chen

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4-14 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/2005 has been entered.

**Examiner's responses to Applicant's remark**

2. Applicant's amendments and arguments filed on 11/3/2005 have been fully considered.

3. Applicant's arguments associated with the amended Claims 1, 13, and 14 are persuasive. (See Examiner's statement of reasons for the indication of allowable subject matter below.)

4. The Examiner apologizes the mistake of indicating implicit incorporation of Japanese patent application laid-open No. 10-1051651 in paper #20050613. The error is corrected below.

Art Unit: 2625

5. Applicant's argument with regard to incorporation of essential material in the specification by reference (paragraph 3 set forth in paper #20040928) is considered, but is not persuasive. The Applicants argued that no essential material is missing from the application.

The point at issue is whether the incorporation is proper or not. MPEP clearly states that a foreign application cannot be incorporate any essential material. Thus, the issue is that (1) Japanese patent application laid-open No. 10-1051651 is a foreign application and (2) it contains essential material. Claim 1 is at least supported by the second paragraph, page 8 of the substitute specification. This paragraph discloses an embodiment that includes how one can process images of all kinds of formats. Furthermore, when the result of the analyzing step indicates that the drawing instructions contain data other than compressed data, an attribute of each image is judged according to the kind of each drawing instruction in a manner as described in Japanese Patent Application Laid-open No. 10-051651. These results are needed for the developing step recited in Claim 1. Thus, the material in Japanese patent application laid-open No. 10-1051651 is essential for implementing the whole embodiment.

The objection can be overcome by including English description of relevant parts of Japanese patent application laid-open No. 10-1051651. The Examiner will not consider this inclusion new matter.

### ***Specification.***

6. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the

Art Unit: 2625

disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Japanese patent application laid-open No. 10-1051651 is incorporated in page 8 of the substitute specification.

### ***Allowable Subject Matter***

7. Claims 1 and 4-14 are allowed.

The following is a statement of reasons for the indication of allowable subject matter. The prior art fails to teach the method of Claim 1, the medium of Claim 13, and the apparatus of Claim 14 which specifically comprise the following features in combination with other recited limitations:

**--analyzing whether compressed data contained in a drawing instruction corresponds to an image attribute, a text attribute or a graphics attribute by discriminating a format of the compressed data;**

**-- performing correction processing on the bit map according to the attribute identified on the basis of the analysis result.**

Art Unit: 2625

The presently amended Claims 1, 13, and 14 are different from their respective previous versions by explicitly requiring “analyzing compressed data to determine attributes, that will later be used for correction, by discriminating a format of the compressed data.” Gentile fails to teach this feature. More specifically, the attributes taught by Gentile are not generated by discriminating a format of the compressed data.

### *Conclusion*

8. This application is in condition for allowance except for the following formal matters: the objection to specification set forth above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wenpeng Chen whose telephone number is 571-272-7431. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular

Art Unit: 2625

communications and 571-273-8300 for After Final communications. TC 2600's customer service number is 571-272-2600.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

Wenpeng Chen  
Primary Examiner  
Art Unit 2625

A handwritten signature in black ink, appearing to read 'Wenpeng Chen', with a stylized, flowing script.

1/20/2006